

## **REMARKS**

Claims 1-49 and 51-123 were pending and presented for examination. In an Office Action dated September 11, 2008, all pending claims were rejected. In view of the Amendments herein and the Remarks that follow, Applicants respectfully request that Examiner reconsider all outstanding rejections and withdraw them.

### **Response to Rejection under 35 U.S.C. § 103(a)**

Claims 1-4, 7-8, 15-16, 18-23, 35, 42-43, 47, 62, 65, 74, 78-81, 84-85, 92-93, 95-100, 112-120 and 123 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugiyama (US Patent 5,633,723) in view of Steele (US Patent 5,884,056) and Chino (US Patent 6,188,888). Claims 5-6 and 82-83 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugiyama in view of Steele, Chino and Kametani (US Patent 5,091,948). Claims 9-11, 14, 86-88 and 91 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugiyama in view of Steele, Chino and Halverson (US-2002/0101513). Claims 12-13, 89-90 and 121 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugiyama in view of Steele, Chino, Halverson and Kametani. Claims 17, 25-31, 76, 94 and 102-108 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugiyama in view of Steele, Chino, and Krumm (US Patent 6,611,622). Claims 24 and 101 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugiyama in view of Steele, Chino, and Kim (US Patent 6,594,377). Claims 32-34 and 109-111 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugiyama in view of Steele, Chino, and Gerber (US Patent 5,568,406). Claims 36-39, 44-45, 51-58, 63, 73, and 75 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugiyama in view of Steele, Chino, and Hymel (US

2003/0220988). Claims 40-41, 49, 59-61, 69 and 77 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugiyama in view of Steele, Chino, and Stevens (US 2002/0010641). Claims 46, 64, 66-68 and 71 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugiyama in view of Steele, Chino, Stevens, and McCarthy (US Patent 6,296,693). Claim 48 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugiyama in view of Steele, Chino, and Wedekind (US Patent 5,115,967). Claim 70 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugiyama in view of Steele, Chino, and Rowe (US 2001/0003846). Claim 72 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugiyama in view of Steele, Chino, and Abgrall (US Patent 6,373,498). Claim 122 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugiyama in view of Steele, Chino, Krumm, and Kim. These rejections now are traversed.

Claim 1 now recites a system for printing time-based media, comprising, *inter alia*:

a user interface display on the multifunction printer that displays a function selection menu comprising a plurality of user-selectable audio and video range selection functions to be applied to the time-based media by a processor within the multifunction printer

As a preliminary matter, Applicants note that the Examiner is forced to rely on three separate references for this single element of the claimed invention: Sugiyama for a printer allowing user input, Steele for video aspects, and Chino for audio aspects. However, the cited references do not disclose or suggest this element of the claimed invention alone or in the suggested combination.

Steele merely discloses video browsing using minimal bandwidth over the World Wide Web. When a user selects a video for viewing, Steele displays a number

of still frames from a video to the user. After the user selects two frames for viewing, Steele displays frames that temporally lie between the two selected frames. Steele, Abstract.

The Examiner cites Figure 6 and col. 7, l. 62 – col. 8, l. 2 of Steele for disclosing a user interface with a function selection menu including user-selectable video range functions. However, this section of Steele refers to a menu displaying *video files or thumbnails*. However, Steele’s files/thumbnails are not “user-selectable video range selection functions to be applied to the time-based media”; it is unclear what the Examiner believes to show the claimed “**video range selection functions.**” Steele therefore does not disclose even the aspects of this element for which the Examiner relies upon the reference.

Chino does not remedy the deficiencies of Steele, nor does the Examiner allege that it does. Rather, Chino at col. 14, ll. 8-18 is relied upon for disclosing user-selectable audio range functions. However, Chino merely discloses a multi-modal apparatus that displays a pictorial indication of a request for user audio input. When the computer does not expect an audio input from the user, the computer inactivates its audio input module. Chino, col. 14, ll. 8-18. It is unclear what the Examiner believes to show the claimed “**audio range selection functions.**” Chino also does not disclose even the aspects of this element for which the Examiner relies upon the reference.

Sugiyama further does not remedy the deficiencies of Steele and Chino, nor does the Examiner argue that it does. The Examiner argues that Sugiyama’s memory and other keys correspond to the “user interface **display** on the multifunction printer that **displays** a function selection menu.” However, Sugiyama merely discloses a

printer that allows a user to select individual video frames for printing. To print an image, the user selects a memory key 21 to freeze a displayed image and then initiates printing with a print key 23. *See* Sugiyama, col. 4, ll. 45-54. However, Sugiyama keys do not comprise a **user interface display**, nor do they **display a function selection menu**. Accordingly, Sugiyama also does not disclose even the aspects of this element for which the Examiner relies upon the reference.

Thus, the deficient disclosures of these references, considered either alone or in combination, fail to establish even a *prima facie* basis from which a proper determination of obviousness under 35 U.S.C. § 103(a) can be made. As discussed above, the references do not teach or suggest all of the claimed limitations.

Additionally, even assuming *arguendo* that the references showed what the Examiner proffers, the combination still would not disclose this claim element. At best, the combination would suggest a video printer capable of browsing online videos and a multi-modal interface to receive audio from the user. However, the claim element recites “a user interface display on the multifunction printer that displays a function selection menu comprising a plurality of user-selectable audio and video range selection functions to be applied to the time-based media by a processor within the multifunction printer.”

The Examiner appears to suggest as part of his argument that the references are combinable that a user interface can be adaptable to any function. Applicants do not contest that user interfaces are known in the art as, and are adaptable as, interfaces between a user and *user-controlled functions*. However, allowing a user to select various video and audio range selection functions on a multifunction printer is not

known in the art. The Examiner has provided no reference to show a user interface on a printer that provides a menu with user-selectable audio and user-selectable video range functions.

Moreover, Examiner's suggested combination would require the references to be modified well beyond their "established functions," precluding the "predictability" of such combining. Thus, the discussion above indicates that the claimed invention is "more than a predictable use of [these] prior art elements according to their established functions." See *KSR*, *KSR*, 550 U.S. 398 (2007).

Finally, the Examiner alleges that the combination would be obvious to one of skill in the art. A question raised by the Examiner's selection of cited references is *which* art? Sugiyama is directed towards video printers that include a data deletion feature involving mute. Steele is directed towards browsing video frames when a video file is subject to data throughput constraints. Chino is directed at addressing communication gaps between a computer and a user. One of skill in the relevant art, video printing, likely would not be motivated to look to audio communication between a user and computer, nor online video browsing.

Claim 1 therefore is patentably distinguishable over Sugiyama, Steele, and Chino, alone or in the suggested combination.

Independent claim 78 also is patentably distinguishable over Sugiyama, Steele, and Chino for the above reasons. Dependent claims 2-49, 51-77, and 79-123 variously depend from claims 1 and 78, shown above to be patentably distinguishable over the cited reference. All arguments advanced above with respect to claims 1 and 78 are hereby incorporated so as to apply to claims 2-49, 51-77, and 79-123. All other

references cited against the dependent claims do not remedy the deficiencies of Sugiyama, Steel and Chino, nor does the Examiner allege that they do. Thus, claims 2-49, 51-77, and 79-123 are patentably distinguishable over the cited references for at least the reasons stated above in addition to the further patentable limitations recited therein.

### **Conclusion**

In sum, Applicants respectfully submit that claims 1-49 and 51-123 as presented herein, are patentably distinguishable over the cited references. Therefore, Applicants request reconsideration of the basis for the rejections to these claims and requests allowance of them.

In addition, Applicants respectfully invite the Examiner to contact Applicants' representative at the number provided below if the Examiner believes it will help expedite furtherance of this application.

Respectfully submitted,  
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